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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,881	10/19/2005	William H Shepard	05918-336US1	5888
26161 7590 04/04/2007 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER SALVATORE, LYNDIA	
			ART UNIT	PAPER NUMBER
			1771	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/524,881

Applicant(s)

SHEPARD ET AL.

Examiner

Lynda M. Salvatore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/14/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 10-12, 16-23, 29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) 18-23, 29 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10-12, 16-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/31/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.
2. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.
3. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.
  - I. Claims 1-3, 10-12, 16 and 17 drawn to building construction material classified in class 428, subclass 100+.
  - II. Claims 18-23, 29 and 31, securing the building construction material, classified in class 24 and 442, subclass various.
4. The inventions listed as Groups I -III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more technical features. Specifically, the term "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. In the instant case, the laminate recited in independent claim 1 does not define a contribution over the prior art. For example, the prior art of WO 99/11452 and 5,224,895 teaches the laminate of claim 1.
4. During a telephone conversation with James Babineau on 3/14/07 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-3, 10-12, 16 and 17. Affirmation of this election must be made by applicant in replying to this Office action. Claims

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18-23,29 and 31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Applicant is advised that the reply to this requirement to complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 571-272-1482. The examiner can normally be reached on M-F.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 10-12, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shepard et al., WO 99/11452 in view of Franz, US 5,224,895.

Shepard et al. discloses a light weight nonwoven loop material for hook and loop fasteners. The nonwoven material is stretched and stabilized to produce spaced-apart loop

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clusters extending from taut fibers (abstract). Binder is added to the nonwoven to stabilize the structure in amount of between 20% and 40% of the total weight of the web (page 2, line 30 - page 3, line 3). The nonwoven material has a basis weight of less than 4 oz/yd<sup>2</sup>, preferably less than 2 oz/yd<sup>2</sup> (pages 1 - 2). The material is produced such that the fabric has tight knot regions made up of fibers between which are low density areas (page 13, line 35 - page 14, line 4). Also, the fabric can be produced by needles to form entanglements (page 22). While Shepard discloses that the loop product can be used in display systems (page 27), Shepard fails to teach what type of material is used to make the display system.

Franz is drawn to a hook-and-loop display system. Franz discloses that the display system can be made from durable plastic or paper materials of any desired thickness or strength (column 4, lines 10 - 16). Further, pieces are designed to be releasably attached to the nonwoven hook-engageable surface. With specific regard to claim 3, the recitation of "at least as great as that of 85 pound Kraft paper", it is the position of the Examiner that such a recitation is not considered a positive limitation in any patentable sense. As such, the Examiner considers the paper taught by Franz just as stiff as that of 85 lb Kraft paper. If having 85 lb Kraft paper is critical to the novelty of the claimed laminate, then it is suggested that Applicant positively claim 85 lb Kraft paper.

Therefore, it would have been obvious to one having ordinary skill in the art to choose a display system made from paper, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. One of ordinary skill would choose paper, since paper is light-weight, flexible, easy to roll or wind, readily available, and inexpensive.

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With regard to the denier and percentage of areal stretch, Sherpard et al., does not specifically teach the claimed fiber denier and percentage of areal stretch, however, it is the position of the Examiner that it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the non-woven material of Shepard et al., with fibers of a suitable denier and with desired areal stretch as function of desired use. It has been held that discovering an optimum value of result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 UPSQ 215

With regard to claim 16, it is the position of the Examiner that bulk materials such as the laminate formed by the combination of prior art is commonly packaged and stored in roll form for easy transport. The Examiner does not consider any thing particularly novel about providing the laminate material in roll form.

With regard to claim 17, it is the position of the Examiner that since Franz specifically teaches a display system comprising paper it is obvious that at least one side is exposed for the purpose of displaying an image. Applicant is invited to prove otherwise.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,342,285

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M. Salvatore whose telephone number is 571-272-1482.

The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

March 29, 2007

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